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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/390,583	09/02/1999	PER JUST ANDERSEN	11527.209	7141

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EXAMINER

ROCHE, LEANNA M

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 11/27/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/390,583

Applicant(s)

ANDERSEN ET AL.

Examiner

Leanna Roche

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 32-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 32-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 19.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. The amendments filed on October 9, 2001 have been entered and carefully considered. Claims 32-53 are pending in this application.

#### ***Terminal Disclaimer***

2. The terminal disclaimer filed on October 9, 2001 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of any patent granted on application number 08/327,524 has been reviewed and is accepted. The terminal disclaimer has been recorded.

#### ***Reissue Applications***

3. This application is objected to under 37 CFR 1.172(a) as lacking the written consent of all assignees owning an undivided interest in the patent. The consent of the assignee must be in compliance with 37 CFR 1.172. See MPEP § 1410.01.

A proper assent of the assignee in compliance with 37 CFR 1.172 and 3.73 is required in reply to this Office action.

4. This application is objected to under 37 CFR 1.172(a) as the assignee has not established its ownership interest in the patent for which reissue is being requested. An assignee must establish its ownership interest *in order to support the consent to a reissue application required by 37 CFR 1.172(a)*. The submission establishing the ownership interest of the assignee is informal. There is no indication of record that the

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party who signed the submission is an appropriate party to sign on behalf of the assignee. 37 CFR 3.73(b).

A proper submission establishing ownership interest in the patent, pursuant to 37 CFR 1.172(a), is required in response to this action.

5. The submission establishing ownership interest was signed by applicant's attorney. An attorney or agent of record is not authorized to sign a submission establishing ownership interest, unless he/she has been established as being authorized to act on behalf of the assignee. See MPEP § 324.

6. In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

7. Claims 32-53 are rejected as being based upon a defective Declaration under 35 U.S.C. 251. See 37 CFR 1.175. The nature of the defect is set forth above.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

8. Claims 32-53 are rejected under 35 U.S.C. 251 as being an improper recapture of claimed subject matter deliberately canceled in the application for the patent upon which the present reissue is based. As stated in *Ball Corp. V. United States*, 221 USPQ 289, 295 (Fed. Cir. 1984):

The recapture rule bars the patentee from acquiring, through reissue, claims that are of the same or broader scope than those claims that were canceled from the original application.

The newly amended claims do not contain the limitation that the fibrous material has an average fiber length of greater than about 2 mm. The newly amended claims contain the limitation that the fibrous material has a fiber length less than about 25 mm. Therefore, the newly amended claims read on something that the original claims do not. Specifically, the newly amended claims read on materials, which contain a fibrous material, having an average fiber length of less than about 2 mm.

It is noted that the limitation that the fibrous material has an average fiber length of greater than about 2 mm was relied upon by the applicants in the original prosecution to distinguish over Tiefenbacher et al. See page 11, first full paragraph to page 13, line 3 of Paper No. 7 dated March 18, 1996 in U.S. Serial No. 08/327524, where it is argued that "[e]ach of independent claims 1, 23, 30 and 49 was originally drafted to include the limitation that the 'fibers hav[e] an average fiber length greater than about 2 mm'. In contrast, *Tiefenbacher et al.* teaches away from the use of fibers larger than 1.5 mm, as discussed hereinbelow. The ability to successfully mold a starch-bound article having fibers that have 'an average fiber length greater than about 2 mm' is made possible by the inclusion of pregelatinized starch component in significant quantities within the starch-based composition during the mixing process... This results in much more effective dispersion of the fibers, particularly 'fibers having an average fiber length greater than about 2 mm... [F]ibers having an average fiber length greater than about 2 mm' are an important component because they provide an important reinforcing function within the molded starch-bound articles... it is clear that *Tiefenbacher et al.* fails

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to teach or suggest the tremendous strengthening effect of the fibers, particularly well-dispersed fibers having an average length greater than about 2 mm.”

### ***Response to Arguments***

9. In view of the Terminal Disclaimer filed on October 9, 2001, the previous rejection under the judicially created doctrine of obviousness-type double patenting has been withdrawn.

10. Applicant's arguments filed October 9, 2001 have been fully considered but they are not persuasive. Applicant states that newly amended claims 32-53 are similar to previous reissue claims 32-5[1] and are proper for reissue for at least the same reasons given with respect to previous reissue claims 32-51. Therefore, the Examiner's response to Applicant's arguments concerning previous reissue claims 32-51 is directed to newly amended claims 32-53.

11. Applicant argues:

previous reissue claims 32-51 are clearly narrower in scope than any of the claims that were actually cancelled or not allowed in the original application. Based upon the rule articulated in Ball, previous claims 3[2]-5[1] are proper for reissue because they are clearly not “of the same or broader scope than those claims that were cancelled from the original application.”

As disclosed in the MPEP 1412.03:

a broadened reissue claim is a claim which enlarges the scope of the claims of the patent...A claim of a reissue application enlarges the scope of the claims of the patent if it is broader in *at least one* respect, even though it may be narrower in other respects.

It is the position of the Examiner that newly amended claims 32-53 broaden the scope of the claims of the patent. The patent contained the limitation that the fibrous material

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has an average fiber length of greater than about 2 mm. The newly amended claims contain the limitation that the fibrous material has a fiber length less than about 25 mm. Therefore, the newly amended claims read on something that the original claims do not. Specifically, the newly amended claims read on materials, which contain a fibrous material, having an average fiber length of less than about 2 mm.

**12.** Applicant argues that the examiner has ignored the third part of the three-part test that applies to determining exceptions to the recapture rule. However, the examiner has relied upon the two-part test set forth in the MPEP 1412.02, which includes 1) reviewing each claim for the presence of broadening, as compared with the scope of the claims of the patent to be reissued, and 2) determining whether the broader aspects of that reissue claim relate to subject matter that applicant previously surrendered during the prosecution of the original application. Because, the examiner has shown sufficient evidence that both parts of this test have been met, as set forth in Paper No. 17 and above, the currently pending claims are considered barred by the recapture rule.

**13.** Applicant argues that the Office has not addressed "the issue as to whether previous reissue claims 32-51 were 'materially narrowed in other respects to avoid the recapture rule'." The MPEP 1412.02, under the heading "Reissue Claims are Broader in Scope in Some Aspects, but Narrower in Others," states that the examiner must determine whether the newly added narrowing limitation in the reissue claim modifies the claim such that the scope of the claim no longer results in a recapture of the surrendered subject matter. As stated before, the patent contained the limitation that

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the fibrous material has an average fiber length of greater than about 2 mm. The newly amended claims contain the limitation that the fibrous material has a fiber length less than about 25 mm. Therefore, the newly amended claims read on something that the original claims do not. Specifically, the newly amended claims read on materials, which contain a fibrous material, having an average fiber length of less than about 2 mm. Therefore, the examiner contends that the scope of the claim still recaptures the surrendered subject matter.

**Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leanna Roche whose telephone number is 703-308-6549. The examiner can normally be reached on Monday through Friday from 8:30 am to 6:00 pm (with alternate Mondays off).


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Blaine Copenheaver can be reached on 703-308-1261. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



lmr

November 21, 2001



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